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HEWLETT-PACKARD COMPANY
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EXAMINER

BASHORE, WILLIAM L

ART UNIT PAPER NUMBER

2176

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,478

Applicant(s)

TRENZ, THOMAS

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/21/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: original application filed 3/7/2001, claiming foreign priority date of 8/30/2000. IDS filed 5/21/2001.
2. Reference 1S on said IDS cannot be considered because the examiner cannot verify a date on either said document, or on said URL web site.
3. Claims 1-25 are pending. Claims 1, 9, 17 are independent claims.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The claimed invention as claimed in claims 9-25, are directed to non-statutory subject matter.

In regard to independent claims 9, 17, although claim 9 claims a system, said claim is also claiming “an application program for creating at least one document page”, and “a program component...”. Claim 17 claims “A computer program product including program code...”. Regarding both claims, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. The examiner’s suggestion of amending each said claim to include a program which is embodied on a computer readable medium, will serve to overcome this rejection.

In regard to dependent claims 10-16, 18-25, claims 10-16, 18-25 are rejected for fully incorporating the deficiencies of their respective base claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-2, 5, 7-10, 13, 15-19, 22, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word 2000 (hereinafter Word 2000), Microsoft Corporation, application screenshots pages 1-12, said application released on June 7, 1999, as evidenced by InternetNews article, <<http://internetnews.com/dev-news/article.php/132471>>, pages 1-3, downloaded on October 31, 2004.**

In regard to independent claim 1, Word 2000 teaches a “Print Layout” feature which creates borders around pages (i.e. one page per sheet), splitting sheets accordingly, so as to replicate (preview) pages of a document as they will look when printed (Word 2000 page 2). Word 2000 can also be configured to show multiple pages accordingly (Word 2000 page 12, see also pages 8-9). It is noted that said Print Layout view results in a nine page spread of a displayed sample document (Word 2000 pages 2-3) (compare with claim 1 “*A method performed by a computer system to print a document page on one sheet or split over several sheets, comprising*”).

Word 2000 teaches simultaneously displaying a sample document (i.e. Word 2000 page 4) in a letter “Print View” format, along with display of a Page Setup box (said box comprising a small preview screen of its own, along with a paper size drop down control), allowing a user to change paper size (i.e. from letter to legal) (Word 2000 page 4-6). Changing to legal size paper dynamically changes the document presentation (Word 2000 page 6). Although Word 2000 does not specifically disclose said feature as directly controlling the “number of sheets”, nevertheless, since the skilled artisan is cognizant of the size variation between “letter” and

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“legal” paper sizes, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret the changing of paper sizes as a way to modify the number of sheets to be displayed and printed, as exemplified by reorganization into seven sheets (from the original nine) by using legal sized paper, said sheets split accordingly (Word 2000 page 7). The applied teaching provides a user of Word 2000 the benefit of multiple size paper selection to see exactly how a document will look when printed (compare with claim 1 *“simultaneously displaying on a computer display....or the number of sheets”*, and *“dynamically changing the displayed sheet splitting in response to a corresponding actuation of the control element”*).

Word 2000 teaches a print feature for printing pages of a document as it appears in “Print Layout” view (Word 2000 page 10; compare with claim 1 *“printing the document page according to the displayed sheet splitting upon receiving a print command.”*).

In regard to dependent claim 2, Word 2000 teaches a “Print Layout” embodiment, implemented by the Word 2000 application (Word 2000 pages 1-12).

In regard to dependent claim 5, Word 2000 teaches a form of drop down graphical slider menu (Word 2000 page 4 – slider on right side of “Paper Size” drop down menu) for selection of paper sizes having an obvious effect on number of sheets (as explained above).

In regard to dependent claim 7, Word 2000 teaches a feature to display/print page numbering accordingly (the examiner has traced the pre-existing page numbers for clarity) (Word 2000 page 4). The page numbers locate each sheet/page within a document, and are dynamically changed.

In regard to dependent claim 8, Word 2000 teaches shifting of sheet splits relative to the original page (letter vs legal) (Word 2000 pages 4, 6).

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In regard to claims 9, 10, 13, 15, 16, claims 9, 10, 13, 15, 16 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 1, 2, 5, 7, 8 respectively, and are rejected along the same rationale.

In regard to claims 17, 19, 22, 24, 25, claims 17, 19, 22, 24, 25 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 1, 2, 5, 7, 8 respectively, and are rejected along the same rationale.

In regard to dependent claim 18, since Word 2000 is an electronic application, it is typically shipped on CDs. It is also well established that Word 2000 provides for saving documents onto hard drives and diskettes.

8. **Claims 3-4, 11-12, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Word 2000, as applied to claims 1, 9, 17 above, and further in view of Goodman et al. (hereinafter Goodman), U.S. Patent No. 6,757,071, filed November 9, 1999, issued June 29, 2004.**

In regard to dependent claim 3, Word 2000 does not specifically teach the methods of the claimed invention implemented by a printer driver. However, Goodman teaches an intelligent printer driver for generating documents, whereby said driver comprises a print pre-viewer for displaying document (Goodman column 9 lines 13-17), and a recommendation module for automatically re-sizing a document (Goodman column 9 lines 32-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goodman's intelligent printer driver to Word 2000's processes as explained above, providing Word 2000 the benefit of decreasing the workload on Word 2000's own resources, and for interfacing with various printers.

In regard to dependent claim 4, Word 2000 teaches a print job whereby a user can select a larger or smaller size paper accordingly, as well as utilizing Page Layout controls accordingly (Word 2000 pages 4, 11).

In regard to dependent claims 11, 12, claims 11, 12 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 3, 4 respectively, and are rejected along the same rationale.

In regard to dependent claims 20, 21, claims 20, 21 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 3, 4 respectively, and are rejected along the same rationale.

9. **Claims 6, 14, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Word 2000, as applied to claims 1, 9, 17 above, and further in view of Ilsar, U.S. Patent No. 6,694,487, filed December 10, 1998, issued February 17, 2004.**

In regard to dependent claim 6, Word 2000 does not specifically teach overlaying a preview with a grid. However, Ilsar teaches a page preview comprising a resizing grid, said grid overlain upon a document, said grid used for resizing purposes (Ilsar Abstract – especially at middle, also column 5 lines 41-50, column 6 lines 35-46, column 10 lines 15-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ilsar to Word 2000, providing print previewing which is easily tailorable (Ilsar column 2 lines 30-35). It is noted that Ilsar's invention can be integrated into various applications, such as Word 97 (see Ilsar column 7 lines 52-67).

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In regard to dependent claim 14, claim 14 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 6, and is rejected along the same rationale.

In regard to dependent claim 23, claim 23 reflects the computer program product comprising computer readable instructions used for implementing the methods as claimed in claim 6, and is rejected along the same rationale.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William L. Bashore
Patent Examiner AU 2176
October 30, 2004